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By

(Signature of person mailing)

Patricia Botelho

(Typed or printed name of person)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

IN RE APPLICATION OF: Marshall D. Crew, et al.

Examiner: Unknown

APPLICATION NO.: 10/066,091

FILING DATE: February 1, 2002

:Group Art Unit: 1614

TITLE: Pharmaceutical Compositions of Cholesteryl  
Ester Transfer Protein Inhibitors

Commissioner for Patents  
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Response To Restriction Requirement

This is in response to the Office Action, a restriction requirement, mailed on April 23, 2003 in the above-identified application, the term for response having been extended three (3) months by including the appropriate fee and petition herewith.

As a preliminary matter, please note the Associate Power Of attorney enclosed herewith in favor of the undersigned attorney.

Applicants herewith elect the invention of Group I, claims 1-5 and 19-25, with traverse. The Restriction Requirement is traversed on the basis that it is excessive. It is noted that three out of four of the restriction groups, i.e., all of the Groups except Group IV, are classified in exactly the same class and subclass, class 514, subclass 772.4. A search for any one of Groups I, II, or III necessarily represents a search for the remaining two Groups as well since the Examiner must search the exact same classification for each group. MPEP 803 states that if the search and examination of an entire application can be made without serious burden, the Examiner must examine it on the merits, even though it includes claims to independent or distinct inventions. Thus if the Examiner is already searching the invention of Group I which Applicants have elected, the Examiner will be searching the same classification that is pertinent to Groups II and III as well. It is respectfully submitted, per MPEP 803, that it would not be a serious burden on the Examiner to consolidate at least Groups I, II, and III, as opposed to placing the burden and expense of filing and prosecuting three different applications on Applicants, all of which applications can be searched together.

Accordingly, the Examiner is respectfully requested to reconsider the restriction requirement. Even if the Examiner chooses not to withdraw the requirement *in toto*, it is requested that at least some of the groups that can be searched together be consolidated. Applicants will defer amending the claims pending the Examiner's response.

The Examiner appeared to have made an election of species requirement as well. The first three subparagraphs under Paragraph 4 state the following:

4. This application contains claims directed to the following patentably distinct species of the claimed invention: Three separate method of preparing a pharmaceutical and a composition are claimed.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, claims 1, 6, 13 and 26-29 are generic.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election. (Pages 3-4 of the Office Action).

The requirement is not understood on the basis that the Examiner did not state what the species were for election (from the above quotation, the stated species would appear to be the same as the restriction groups - - three methods and a composition). In an effort to clarify the election of species requirement, the undersigned attorney telephoned the Examiner on August 12, 2003. During the conversation the attorney stated that it was Applicants' intention to elect the invention of Group I. The Examiner stated that if Group I were elected, there would be no need to make an election of species. Given the Examiner's statement, and because Group I has in fact been elected, the election of species requirement is believed to be moot, and no election has been made.

Action on the merits, especially a Notice of Allowance, is respectfully requested.

Respectfully submitted,

Date: AUGUST 13, 2003

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